

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL13096

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
 on Filed Electronically on July 13, 2010

Signature /Mitchell K. McCarthy/Typed or printed Mitchell K. McCarthy
name _____

Application Number

09/760,242

Filed

1/12/2001

First Named Inventor

Robert J. Davidson

Art Unit

2623

Examiner

James R. Shelehedra

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

/Mitchell K. McCarthy/

Signature

assignee of record of the entire interest.

Mitchell K. McCarthy

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Typed or printed name

attorney or agent of record.

Registration number 38,794

405-639-3082

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

July 13, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Filed Electronically on July 13, 2010

**PATENT
Dkt. STL 13096**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Robert J. Davidson**

Assignee: **SEAGATE TECHNOLOGY LLC**

Application No.: **09/760,242**

Group Art: **2623**

Filed: **1/12/2001**

Examiner: **James R. Shlehedra**

For: **PERSONAL MOVIE STORAGE MODULE**

**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

APPLICANT'S REMARKS FOR PRE-BRIEF REQUEST FOR REVIEW

Claims 1-5, 8, 9, 11-15, 19, 20, 24-26, 32, and 37-39 are Novel and Non-Obvious Over the Cited References

Independent claims 1 and 9 are allowable at least because none of the art of record, neither alone nor combined, teaches or suggests a method or apparatus for encoding the device in which entertainment media resides with a usage condition without having to modify the entertainment media itself.

The Office's Claim Interpretation Leaves an Unresolved Factual Issue
Making the Case Not in Condition for Appeal

Independent claims 1 and 9 both explicitly define “non-encoded entertainment media” to mean that the entertainment media is not encoded with any usage condition:

non-encoded entertainment media that is not encoded with
any authorized usage condition....¹

Independent claims 1 and 9 both also feature encoding the portable device to define a usage condition of the previously stored non-encoded entertainment media:

after the storing step is completed, encoding the portable
digital storage module with access instructions defining a

¹ Excerpt of claim 1 (emphasis added); claim 9 similarly recites non-encoded entertainment media that is not encoded with any usage condition....

*prescribed authorized usage condition of the stored non-encoded entertainment media.*²

The plain meaning of the language of these claims is that the encoding defines a usage condition of the already stored non-encoded entertainment media. Again, the “non-encoded entertainment media” by definition means that it does not itself include a usage condition.

The Office’s claim interpretation fails to recognize that the claim plainly features the entertainment media remaining “non-encoded” after the encoding:

On page 8, of applicant’s response, applicant argues that claim 1 plainly features an encoding step that encodes the module to define a usage condition without encoding the stored non-encoded entertainment media. In response, it is noted that his [sic: this] feature is not required by the claim and is also not supported by applicant’s specification. The encoding step refers to the previous step of storing non-encoded entertainment media. There is no recitation of the entertainment media being required to be “non-encoded” after the encoding step occurs.³

The encoding step occurs after the storing step is completed. The result of completing the storing step is that the non-encoded entertainment media is stored to memory. Again, the stored non-encoded entertainment media by definition does not itself define a usage condition. The result of the encoding step is that access instructions are encoded to the portable device. Those access instructions plainly define the usage condition. The usage condition is claimed, via antecedent basis, as controlling *the stored non-encoded entertainment media.*

For the sake of argument, if the encoding added the access instructions to the stored non-encoded entertainment media, as the Office suggests is permissible by the claim, then it would be indefinite to refer to the usage condition as controlling the non-encoded entertainment media because the non-encoded entertainment media no longer exists when it is modified to include the access instructions. Furthermore, in that scenario the access instructions (and hence the usage condition) and the non-encoded entertainment media could not possibly co-exist, contrary to the plain meaning of the claim language.

² Excerpt of claim 1 (emphasis added); claim 9 similarly recites *a controller...configured to respond to access instructions that are encoded to the digital storage module...after the non-encoded entertainment media has been stored to the memory...to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.*

³ Office Action of 4/13/2010 pg. 2.

The Office's rationale is misplaced in that it fails to recognize that the rejected claims plainly feature the non-encoded entertainment media still existing and referenced by antecedent basis after the encoding. That leaves an unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

The Office's Interpretation of Kawakami Leaves an Unresolved Factual Issue
Making the Case Not in Condition for Appeal

Applicant has shown in the record that Kawakami discloses always storing encoded content to the portable devices; the content being encoded with usage condition information.⁴ For example, Applicant has shown that Kawakami explicitly discloses the data transferred to the portable device is in the form of a packet composed of a header and a content, the header defining the usage condition information:

A data to be transferred to the portable device 6 is composed of a header and content. The header stores a content ID, file name, header size, content key, file size, codec ID, file information, etc. and also a playback limitation data, start date, end date, playback limit, playback counter, etc., necessary for the playback limitation.⁵

In addition to a new rationale in the pending action, discussed below, the Office also repeats its previous rationale in the pending action:

In an analogous art, Kawakami discloses a content delivery system (Fig. 1) wherein non-encoded digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55)...⁶

Applicant reiterates its previous traversal of that rationale because it is a misplaced characterization of what Kawakami actually discloses for the reasons previously placed in the record.⁷ The fact that the Office maintained the rationale in response to Applicant's previous rebuttal leaves an unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

⁴ Applicant's Response of 4/5/2010 ppg. 8-9, note 3.

⁵ Kawakami col. 10:32-37 (emphasis added).

⁶ Office Action of 4/13/2010 pg. 4 (emphasis added).

⁷ Applicant's Response of 4/5/2010 ppg. 8-9.

The Office's new rationale in the pending action points to Kawakami's disclosure in FIG. 19:

In response, to applicant's arguments on pages 8-9 regarding Kawakami, it is noted that Kawakami discloses two separate pieces of information, the content and the usage data. As seen in Fig. 4, they are separately stored and processed pieces of data (content file 161-1 and usage rule file, 162-1). As seen in Fig. 19, the content is transmitted to the portable device first (S119-S120). After the content is stored in the portable device, the usage rules are then converted to the proper format and transmitted to the portable device (S121-124). Thus, Kawakami clearly discloses storing the entertainment media without "encoding" it with the usage conditions, as it is explicitly disclosed as being a separate data file which is downloaded to the portable device prior to the usage conditions.⁸

The entirety of the disclosure associated with Kawakami's FIG. 19 is on the face of FIG. 19 itself, because neither FIG. 19 nor any of its constituent blocks S119-S126 are substantively discussed or even referred to; FIG. 19 is merely mentioned in Kawakami's brief description of the drawings section. The Office's stated interpretation is that blocks S119 and S120 allegedly disclose the content alone being stored to the portable device. However, the skilled artisan having read Kawakami recognizes the Office's interpretation is wrong because block S120 discloses the portable device will store the music data already transferred. Kawakami discloses the music data is the usage condition information, such as but not limited to that depicted in the music data base in FIG. 11 and the descriptions thereof.⁹ The skilled artisan reasonably assumes from the sparse disclosure of FIG. 19 that the music data already transferred was previously transferred with the content in block S119. There is nothing in Kawakami that would lead the skilled artisan to believe that block S119 transfers only the content. The interpretation that the music data is transferred with the content is consistent with the entirety of Kawakami's disclosure, including but not limited to the passage of Kawakami cited above that generally

⁸ Office Action of 4/13/2010 pg. 3 (emphasis added).

⁹ FIG. 11 discloses the music data base includes usage condition information such as PLAYBACK CONDITION; START DATE; PLAYBACK CONDITION; END DATE; PLAYBACK CONDITION; PLAYBACK LIMIT; PLAYBACK COUNTER; PLAYBACK ACCOUNTING CONDITION; COPYING CONDITION; COPIES; COPY COUNTER; COPYING CONDITION; SCMS.

defines the transferred data being in a packet composed of a header (containing the usage condition information) and the associated content.¹⁰

The Office has failed to substantiate evidence that rebuts Applicant's showing that Kawakami always encodes the content with usage condition information. The Office's latest rationale, like the previous rationale, is a misplaced characterization of what Kawakami actually discloses. The fact that the Office's rationale upon which the final rejection rests is based on a misplaced characterization of a substantively important disclosure of the cited reference leaves an unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

The Office's Newly Raised Assertion of an Alleged Non-Reference Deficiency Without a Concomitant Rejection or Objection Leaves an Unresolved Factual Issue Making the Case not in Condition for Appeal

In the pending action the Office's rationale appears to set forth an alleged basis for a non-reference rejection or objection.¹¹ There is no pending non-reference rejection or objection. The Office's newly raised rationale without a concomitant non-reference rejection or objection clouds the record, leaving Applicant without the opportunity for due recourse to rebut the Office's full rationale for the rejections/objections on appeal. This leaves an unresolved factual issue that must be addressed before it can be said that this case is in condition for appeal.

Conclusion

For these reasons, Applicant respectfully requests that the Panel find the pending claims allowable or alternatively reopen the merits so that at least these unresolved issues can be addressed.

By: Mitchell K. McCarthy

Mitchell K. McCarthy, Registration No. 38,794

McCarthy Law Group

Telephone: 877.654.6652 or 405.639.3082

www.mccarthyiplaw.com

¹⁰ Note 6.

¹¹ Office Action of 4/13/2010 ppg. 2-3.